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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
| 09/121,628 | 07/23/98 | SULLIVAN | SLP 2-895-1 |

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EXAMINER
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| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 1713 | |

DATE MAILED: 08/02/99

Please find below and/or attached an Office communication concerning this application or proceeding.

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| APPLICATION NUMBER | FILING DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO. |
|--------------------|-------------|-----------------------|------------------|

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EXAMINER

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| ART UNIT | PAPER NUMBER |
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DATE MAILED:

Remain
8/21/99This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 10/29/98☐ This action is **FINAL**.☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-13 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.☐ Claim(s) _____ is/are allowed.☒ Claim(s) 1-13 is/are rejected.☐ Claim(s) _____ is/are objected to.☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.☐ The drawing(s) filed on _____ is/are objected to by the Examiner.☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.☐ The specification is objected to by the Examiner.☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been☐ received.☐ received in Application No. (Series Code/Serial Number) _____☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of Reference Cited, PTO-892☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____☐ Interview Summary, PTO-413☒ Notice of Draftsperson's Patent Drawing Review, PTO-948☐ Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES-

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The Newspaper Articles, advertisements etc submitted do not completely identify what the Strata ball is made of. Applicant's claims encompass many materials. The claims could not possibly be commensurate in scope with the showing. The outer cover is said to be Balata in the submitted articles/advertisements. The current claims do not call for Balata in the outer cover.

Claim 5 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The sizes do not appear to be intended.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-13 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-13 of copending Application No. 8-815556. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Why is applicant prosecuting identical applications? The earlier application is under appeal. The instant application should be abandoned.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-38 of U.S. Patent No. 5803831. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims golf balls having a soft outer cover and a hard high acid inner cover (claim 15).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Nesbitt '193 Patent in view of Horiuchi '739.

Nesbitt discloses golf balls having a hard inner cover and softer outer cover. The inner cover can be Surlyn 1605 and the outer cover can be Surlyn 1855 (col 3 lines 28-⁴⁰30). The amount of acid in the inner cover ionomer is not limited. Surlyn 1605 has 15% acid (see Parnell col 4 line 65) which borders on applicant's acid range.

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It is known that higher acid ionomers are superior in golf balls (see Horiuchi col 1 line 56). It would have been obvious to use a slightly higher acid ionomer in the inner cover of Nesbitt's ball for the expected improvements.

Claims 1-8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Nesbitt '193 Patent in view of Horiuchi '739 and Sullivan '814.

Nesbitt does not suggest his outer cover as being a blend of hard and soft ionomer.

Blends of hard and soft ionomer are known to provide a balance of distance, spin and durability not obtainable from using a single ionomer (see Sullivan col 3 lines 38-64).

It would have been obvious to use a blend of hard and soft ionomer as Nesbitt's outer cover for the expected benefits.

Claims 1-5, 9-11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Saito '434 Patent in view of Horiuchi '739.

Saito produces golf balls having an inner and outer cover. The inner cover can be an ionomer and the outer cover can be polyester elastomer, polyamide elastomer or urethane elastomer (claim 7). Saito does not point out the acid content of his inner cover ionomer.

It is known that higher acid ionomers are superior in golf balls (see Horiuchi col 1 line 56). It would have been obvious to use a high acid ionomer in Saito's inner cover for the expected benefits.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is (703) 308-2403. The examiner can normally be reached on weekdays from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidlick, can be reached on (703) 308-2462. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Buttner/mm

May 6, 1999

DAVID BUTTNER
PRIMARY EXAMINER
GROUP 1500

